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IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-727

NORMAN H. GRANT, ET AL.,
Petitioners

v.

HERBERT H. SILVESTRI, ET AL.,
Respondents

OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondents respectfully submit that the petition for a writ of certiorari in this case should be denied for the reasons presented herein.

OPINIONS BELOW

The opinion of the United States Court of Customs and Patent Appeals (hereinafter referred to as the CCPA) is reprinted in Appendix B of the petition. The CCPA decision is also reported at 496 F.2d 593. The decision of the Board of Patent Interferences is reprinted in Appendix C of the petition.

JURISDICTION

The jurisdictional requisites are adequately set forth in the petition.

QUESTIONS PRESENTED

It is believed the first question presented by petitioners is too broadly stated to properly frame the issues and that the second question presented by petitioners does not accurately define the issue to be decided by this Court. Respondents submit the following as a more accurate statement of the question presented:

> In reviewing a decision of the Board of Patent Interferences, can the CCPA decide a question of law, which was not decided by the Board of Patent Interferences, having before it all of the evidence relating to this issue which was before the Board of Patent Interferences, where a decision on that question of law is necessary to decide priority of invention.

STATUTORY PROVISIONS INVOLVED

In addition to the statutory authorities cited by petitioners, respondents will refer herein to 35 U.S.C. § 6, 35 U.S.C. § 135, Rule 52(a) of the Federal Rules of Civil Procedure and Patent Office Rule 256(b) which are reprinted in Appendix 1.

STATEMENT OF THE CASE

Petitioners' statement of the case contains a number of unsupported allegations which are not essential for a consideration of the question presented and the following statement of the case is submitted.

Respondents contend that they are the first inventors of a new crystalline form of ampicillin having a low moisture content. This form of ampicillin is claimed in petitioners' patent, U.S. Patent No. 3,144,445 which issued August 11, 1964 on an application filed December

26, 1962, and in respondents' patent application Serial No. 408,191, filed November 2, 1964. The Patent Office declared an interference pursuant to 35 U.S.C. § 135 between petitioners' patent and respondents' application and respondents took testimony by way of depositions to prove that they had made the invention prior to the filing date of petitioners' application for patent. Petitioners did not present any evidence to show that they had made the invention earlier than the filing date of their patent and were therefore restricted to their filing date for their date of invention, *Goodale* v. *Lund*, 96 F.2d 840, (CCPA 1938).

The Board of Patent Interferences held that the evidence in respondents' record did not establish that they had made the invention before petitioners' filing date. The Board of Patent Interferences did not specifically decide the legal question, which was argued before it by petitioners, as to whether or not respondents had "abandoned, suppressed or concealed" the invention. Petitioners did not, as they might have done in accordance with the provisions of Patent Office Rule 256(b), request the Board of Patent Interferences to reconsider or modify its decision to specifically rule on the question of whether respondents had abandoned, suppressed or concealed the invention.

Respondents appealed the decision by the Board of Patent Interferences to the CCPA. Before the CCPA, petitioners not only argued that the Board of Patent Interferences was correct in holding that respondents had not established that they made the invention before petitioners' filing date, but they also argued that respondents had abandoned, suppressed or concealed the invention, see Appendix 2.

The CCPA reversed the decision of the Board of Patent Interferences on the issue of their reduction to practice, holding that the record showed a date of in-

vention by respondents prior to petitioners' filing date. However, the Court could not award priority to respondents without deciding the question of whether respondents had abandoned, suppressed or concealed the invention within the meaning of 35 U.S.C. 102(g) since petitioners had argued this point before it. It therefore looked at the evidence in the record before it, which was the same evidence produced before the Patent Office as required by 35 U.S.C. 144, and decided that respondents had not abandoned, suppressed or concealed the invention. Accordingly, the CCPA reversed the decision of the Board of Patent Interferences and awarded priority of invention to respondents.

ARGUMENT FOR DENYING THE WRIT

There is no need or occasion for a review of the decision by the CCPA in this case since there is no conflict with a decision of another court of appeals, the decision does not relate to an important question of federal law, it does not decide a federal question in a way in conflict with any decision of the United States Supreme Court and the decision does not represent a departure from the accepted and usual course of judicial proceedings.

Petitioners' sole reason for requesting that a writ of certiorari issue is based upon the fact that the CCPA decided the issue of abandonment, suppression and concealment, without this issue having been decided by the Board of Patent Interferences. Petitioners contend (1) that this is a case of first impression, representing the first time that this Court has had an opportunity to review a decision of the CCPA involving an appeal from the Board of Patent Interferences; (2) that the decision is in conflict with decisions of United States Courts of Appeals and with prior decisions of the CCPA; and (3) that the CCPA, in deciding the issue of abandonment, suppression and concealment, departed from normal pro-

cedures of appellate review. These contentions are without merit. Petitioners' real claim to error appears to be based upon the bare fact that the Patent Office was reversed by the CCPA.

Before considering petitioners' arguments in detail, it should be noted at the outset that the facts bearing on the issue of abandonment, suppression or concealment were fully developed before the Board of Patent Interferences. Petitioners themselves vigorously argued the question of abandonment, suppression and concealment before the Board and the CCPA in their brief, see pages 24-27 of petitioners' brief before the CCPA, which pages are attached hereto as Appendix 2. Having themselves asked the CCPA to decide this issue in their favor, petitioners should not now be heard to say that the CCPA should not have decided the issue at all. Thus, it is respectfully submitted that petitioners should be estopped from contending that the CCPA should not have decided the issue of abandonment, suppression or concealment.

At page 8 of their petition, petitioners allege that they only argued the question of abandonment, suppression or concealment before the CCPA because respondents argued this issue in their brief. However, if this were the case, would not petitioners have included in their brief before the CCPA a section arguing petitioners' present contention, viz., that the CCPA does not have the authority to decide this issue and that, if the CCPA held in favor of respondents on the issue of reduction to practice of the invention, the CCPA should then remand the case to the Patent Office for it to decide the issue of abandonment, suppression or concealment? However, petitioners' brief before the CCPA made no such contention and affirmatively asked that Court to decide this issue.

It is submitted that petitioners argued the question of abandonment, suppression or concealment before the CCPA because they knew full well that the CCPA could,

in accordance with its established practice, decide this issue without it having been decided by the Board of Patent Interferences, since *all* questions pertinent to the issue of priority were before it. Indeed, the very decision cited by petitioners at page 7 for the proposition that they could not appeal to the CCPA since they prevailed before the Board of Patent Interferences, *Klemperer* v. *Price*, 271 F.2d 743 (CCPA 1959) states that:

> "It has been repeatedly held by this court, however, that all questions pertinent to the issue of priority of invention are before the court in considering an appeal from the Board of Patent Interferences. . . ."

The long-standing practice in the CCPA has been to consider issues when necessary to a priority decision *even though not specifically passed upon below*, see *Gianladis* v. *Kass*, 324 F.2d 322 (CCPA 1963); *St. Pierre* v. *Harvey*, 233 F.2d 337 (CCPA 1956); and *Sloan* v. *Peterson*, 129 F.2d 330 (CCPA 1942).

The fact that the CCPA will consider an issue not specifically passed upon below based upon the record below is not unique to that court. This Court has itself held that it is not limited in its scope of review but

> ". . . must enter the judgement which should have been rendered by the Court below on the record there before it"

Langes v. *Green*, 282 U.S. 531 (1931); and *Baker* v. *Warner*, 231 U.S. 588 (1913). And, in the *M.O.S. Corporation* v. *John I. Haas Co.*, 375 F.2d 614 (CA 9 1967), it was held that if the issue of validity was litigated in the District Court in a patent infringement case and if the record presented is such as to permit decision on that issue, the Court of Appeals can, and at least where the answer seems clear, should decide the issue of patent validity *even though the District Court did not.*

1. This Is Not a Case of First Impression

Petitioners argue that "this is a case of first impression" and point out that this Court has never reviewed a decision of the CCPA involving an appeal from a determination of the Board of Patent Interferences. However, this Court has declined such opportunities several times in the past in petitions for review on writs of certiorari in intereference cases from the CCPA, see *Switzer et al.*, v. *Sockman et al.*, 333 F.2d 935 (CCPA 1964), cert. denied, 380 U.S. 906 (1965); *Knowles* v. *Tibbetts*, 347 F.2d 591 (CCPA 1965), cert. denied, 383 U.S. 927 (1966); *Krantz et al.*, v. *Olin*, 356 F.2d 1016 (CCPA, 1966), cert. denied 386 U.S. 982 (1967); *Carlson* v. *Woofter*, 367 F.2d 436 (CCPA 1966), cert. denied, 389 U.S. 847 (1967); *Fredkin* v. *Irasek*, 397 F.2d 342 (CCPA 1968), cert. denied 393 U.S. 980 (1968); *Frilette et al.*, v. *Kimberlin et al.*, 412 F.2d 1390 (CCPA 1969), cert. denied 396 U.S. 1002 (1970); and *Kilby* v. *Noyce*, 416 F.2d 1391 (CCPA 1969), cert. denied 400 U.S. 818 (1970).

Thus, Petitioners' allegation that this Court can, for the first time in the history of the patent laws, consider a decision of the CCPA involving an appeal from the Board of Patent Interferences is somewhat misleading since the Court could have considered such a decision in any one of the foregoing cases.

Petitioners contend at pages 9 and 12 that the effect of the CCPA's decision may extend the patent monopoly on the invention in issue from 17 to 28 years. However, this is no reason for reversing the CCPA decision and remanding it to the Board of Patent Interferences and, in fact, is an excellent reason for *not* doing so. Thus, if the case were remanded to the Board of Patent Interferences for further proceedings, the Board would then be required to render a decision as to whether respondents had abandoned, suppressed or concealed the in-

vention. That decision, regardless of the outcome, would doubtedlessly either again be appealed to the CCPA or review thereof would be sought under 35 U.S.C. § 146. Such proceedings would require several years, and, assuming respondents prevailed, the period of exclusivity would be even *more* prolonged than if a patent were issued to respondents in the relatively near future.

2. Decision Not In Conflict With Decisions of U.S. Courts of Appeals or With Prior Decisions of CCPA

Petitioners complain the CCPA erred in making "findings of fact" on the issue of abandonment, suppression or concealment. However, the question of abandonment, suppression or concealment is not one of fact, but is an ultimate question of law, *Brokaw* v. *Vogel*, 429 F.2d 476 (CCPA 1970). In one of their briefs filed before the CCPA, petitioners agreed that the question of abandonment, suppression or concealment is an ultimate conclusion of law but argued that it must be based on findings of fact, see Appendix 3. However, since 35 U.S.C. § 144 provides that the CCPA shall hear and determine an appeal "on the evidence produced before the Patent Office", it is respectfully submitted that it was well within the power of that court to consider and decide the legal question of abandonment, suppression or concealment based upon the evidence produced before the Patent Office, even though that question was not decided by the Board of Patent Interferences.

Moreover, even assuming arguendo that the court did make "findings of fact" in deciding the legal question of abandonment, suppression or concealment, it is respectfully submitted that the CCPA is well within its authority in making a finding of fact from the record before it under the provisions of 35 U.S.C. 144. All of the evidence relating to this issue which was considered by the CCPA was identical to the evidence that was

before the Board of Patent Interferences and none of the evidence was disputed.

The large number of United States Court of Appeals decisions cited at page 14 of the petition and petitioners' argument that United States Courts of Appeals generally remand cases to the lower court to make findings of fact are not apropros. United States District Courts *must* make findings of facts under the provisions of Rule 52(a) of the Federal Rules of Civil Procedure. However, this rule does not apply to the Patent Office and there is no requirement in the Patent Office rules, which have been promulgated under 35 U.S.C. § 6 by the Commissioner of Patents and approved by the Secretary of Commerce, that the Board of Patent Interferences should make specific findings of fact.

Moreover, even a Court of Appeals may make its own findings of fact where the evidence is all documentary and it is in as good a position as the trial court to examine the evidence, *Borden Company* v. *Clearfield Cheese Co.*, 369 F.2d 96, 101 (CA 3 1966). In the present case, the evidence before the Board of Patent Interferences was in the form of depositions and the CCPA was in as good a position as the Patent Office to examine this evidence.

The three ex parte cases cited at page 14 of the petition are not pertinent. In each of these cases, the CCPA remanded to the Patent Office Board of Appeals for clarification of a rejection which the Board had made and *not* to decide a question which it had not decided in its original opinion.

Petitioners argue that the CCPA has in the past remanded cases to the Board of Patent Interferences to obtain its views on the question of abandonment, suppression or concealment when this issue was not decided by the Board of Interferences and that it should have done

so in this case. However, it is clear that it is within the discretion of the CCPA to decide an issue not decided below, see *Gianladis* v. *Kass*, 324 F.2d 322 (CCPA 1963); *St. Pierre* v. *Harvey*, 233 F.2d 337 (CCPA 1956); and *Sloan* v. *Peterson*, 129 F.2d 330 (CCPA 1942). Indeed, one of the very cases cited by petitioners for the proposition that the CCPA should remand the case to the Board of Interferences for further proceedings, *Myers* v. *Feigelman*, 455 F.2d 596 (CCPA 1972) specifically held that the CCPA undoubtedly *does have the power* to proceed on its own and decide questions not reached by the Board which become relevant only because it has reversed the Board on questions which it did reach.

Petitioners' contention fails to recognize the distinction between what a court actually does and what it has the *power* to do. In *Langnes* v. *Green*, 282 U.S. 531 at 538, this Court stated as follows:

> "These decisions simply announce a rule of practice which generally has been followed; but none of them deny the *power* of the court to review objections urged by respondent, although he has not applied for certiorari, if the court deems there is good reason to do so."

So also, the decisions cited by petitioners simply announce the rule of practice which may be followed by the CCPA, but none of them deny the *power* of the CCPA to decide an issue which has not been decided by the Board of Interferences.

Moreover, even if the case were remanded to the Board of Patent Interferences, it is not seen how the Board could possibly come up with a different decision as to abandonment, suppression, or concealment than the CCPA did. The Board would necessarily base its decision on the same evidence which was before the CCPA. Surely, the Board would not arrive at a different conclusion of law based upon the evidence than the decision already reached

by the CCPA, and, if they did reach a different conclusion, the CCPA would surely reverse upon a further appeal.

3. The CCPA In Deciding Issue of Abandonment, Suppression And Concealment Did Not Depart From Normal Procedures Of Appellate Review

Much of what is set forth in the section on pages 16-19 of the petition is a rehash of arguments which petitioners have made in earlier sections. Accordingly, much of what has been said earlier in this opposition is applicable to the arguments made in this section of the petition and will not be repeated herein.

None of the cases cited in this section of the petition stands for the proposition that the CCPA should desist from deciding an issue not considered by the Patent Office when a determination of that issue is necessary to a priority decision. The cited ex parte cases of *In re Tucker*, *In re Mooney*, and *In re Kalter* are not pertinent to an inter partes case since those decisions merely state that the CCPA cannot rule upon a rejection which was not made by the Patent Office Board of Appeals. The fact that the CCPA does not have the authority to make a new ground of rejection has nothing to do with its authority to decide an issue not decided by the Board of Patent Interferences when necessary to a priority decision.

The *National Polychemicals Inc.* v. *U.S.* case discussed at page 17 of the petition is wholly irrelevant. In that case, the CCPA merely stated the obvious, i.e., that it is not a trier of facts. In the present case, the CCPA did not become "a trier of facts" since it decided the issue of abandonment, suppression or concealment based upon the evidence which was developed before the Board of Patent Interferences. The *National Polychemicals Inc.* case does not state that the CCPA could not have de-

cided questions which had not been decided by the Customs Court based upon the evidence before it.

Petitioners further contend that the CCPA should not have decided the issue of abandonment, suppression or concealment since the failure of the Board of Patent Interferences to rule on this point was not set forth as a reason for appeal. However, the reasons for appeal, which are set forth in Appendix 4, clearly did put this issue before the CCPA. Thus, the first and second reasons for appeal, i.e., that the Board erred in awarding priority of invention to petitioners and that the Board erred in not awarding priority of invention to respondents, clearly required the CCPA to decide the issue of abandonment, suppression or concealment. Since both petitioners and respondents vigorously argued the issue of abandonment, suppression or concealment before the CCPA, that Court could not have awarded priority to respondents without deciding that issue.

Furthermore, reasons for Appeal Nos. 31, 32 and 52 each set forth points of error in the decision by the Board of Patent Interferences which relate to the issue of abandonment, suppression and concealment. A single adequate reason of appeal is sufficient to bring an issue before the CCPA, *Ferree* v. *Shephard*, 384 F.2d 1019 (CCPA 1967).

Moreover, even if the question of abandonment, suppression or concealment were not referred to in the reasons of appeal, the CCPA still would have had the authority to decide this issue since it is a question ancillary to priority, *Kratz et al.* v. *Calvert*, 129 F.2d 542 (CCPA 1942).

Finally, this is not the type of case which could be summarily decided in petitioners' favor as was done in *Camp* v. *Pitts* cited at page 19 of the petition. In the *Camp* v. *Pitts* case, this Court summarily held that under

the National Bank Act and the Administrative Procedure Act, a party who is dissatisfied with a ruling of the Comptroller of the Currency is not entitled to a trial *de novo* in a United States District Court. It reached this decision citing a previous decision of this Court, i.e., no new precedent was established. However, if this Court were to remand this case to the Board of Patent Interferences as requested by petitioners, it would clearly set a precedent by indicating that the CCPA does not have the power to decide an issue not decided by the Board of Patent Interferences on the evidence which was before the Board when a decision of that issue is necessary to a determination of priority.

CONCLUSION

The CCPA unanimously concluded based upon the record which was before the Board of Patent Interferences, that respondents had not abandoned, suppressed or concealed the invention. The only issue before this Court is whether the CCPA's decision on this point, based upon the very facts and documents as were before the Board of Patent Interferences and which were fully developed before the Board, was capricious, arbitrary, or clearly erroneous. Respondents submit that the CCPA decision was proper and therefore respectfully urge this Court to deny the petition for review on writ of certiorari to the Court of Customs and Patent Appeals.

Respectfully submitted,

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